

Remarks

Claims 35 to 56 were pending before entry of the present amendment.

Applicants note with appreciation that claim 56 is allowed. Applicants present herein new claims 57 to 62 solely to present the methods of claims 47 to 52 in a format to reflect the language of allowed claim 56. Support for new claims 57 to 62 can be found, *e.g.*, at page 29, line 10 to page 30, line 24, of the substitute specification filed on April 6, 2005. Claims 47 to 52 are canceled solely to expedite prosecution and limit the issues on appeal. Claims 47 to 52 are canceled without prejudice. Applicants reserve the right to pursue the subject matter of the canceled claims in one or more related continuation, continuation-in-part, or divisional applications. No new matter has been introduced. Claims 35 to 46 and 53 to 62 will be pending upon entry of the present amendment.

The specification has been amended to delete the claims to priority from application serial No. 07/440,053, filed November 21, 1989 and application Serial No. 07/399,728, filed August 28, 1989. Accordingly, the new priority date of the present application is May 22, 1990. See M.P.E.P. 201.11(III)G.

The Rejections of Claims 47-52 under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

Claims 47-52 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Without making any admissions to the merits of the Examiner's rejection, Applicants have canceled claims 47 to 52 without prejudice, which renders the rejection of these claims moot. Applicants note with appreciation the Examiner's acknowledgment that claim 56 is allowed (*see*, page 6 of the Office Action dated April 28, 2006). Solely to expedite the prosecution of the present application, Applicants have added new claims 57 to

62 to reflect the language of allowed claim 56. Thus, the rejection under 35 U.S.C. § 112, second paragraph, is moot.

The Rejections of Claims 47-52 under 35 U.S.C. § 101 Should Be Withdrawn

Claims 47-52 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Without making any admission to the merits of the Examiner's rejection, Applicants have canceled Claims 47 to 52 without prejudice, which renders the rejection of these claims moot. In view of the present amendment, Applicants respectfully request that the rejection under 35 U.S.C. § 101 be withdrawn.

The Rejections of Claims 35-40 and 53-55 In View of U.S. Patent No. 5,166,057 Should Be Withdrawn

Claim 35 has been rejected under the judicially created doctrine of statutory type double patenting in view of Claim 27 of U.S. Patent No. 5,166,057 (the "'057 patent"). Claims 35-40 and 53-55 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 8, and 27-20 of the '057 patent. The Examiner contends that Claim 35 is identical in scope to Claim 27 of U.S. Patent No. 5,166,057 (the "'057 patent"). While the claimed subject matter overlaps in scope, the scope is not identical. Claim 27 of the '057 Patent requires that the DNA encodes an RNA which comprises the reverse complement of an mRNA sequence. Claims 35-40 and 53-55 of the instant application requires that the DNA encodes an RNA which comprises the reverse complement of an mRNA coding sequence of a negative strand RNA virus. Therefore, the claims are of different scope and the rejections in view of the '057 patent should be withdrawn.

Conclusion

Applicant respectfully requests that the above amendments be entered and made of record in the present application file.

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Respectfully submitted,

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